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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,175	01/20/2004	Sau Chu Chan	CA920030066US1	2047
58139	7590	05/29/2008		
IBM CORP. (WSM) c/o WINSTEAD SECHREST & MINICK P.C. P.O. BOX 50784 DALLAS, TX 75201				
EXAMINER				
GARG, YOGESH C				
ART UNIT		PAPER NUMBER		
3625				
MAIL DATE		DELIVERY MODE		
05/29/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/761,175

Applicant(s)

CHAN ET AL.

Examiner

Yogesh C. Garg

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 9 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 9 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISD/CC)
Paper No(s)/Mail Date 1/20/04, 9/19/07, 2/29/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Preliminary amendment filed 5/16/2008 is entered. Claims 1, 9 and 12 are amended and claims 2-8, 10-11 and 13-20 are canceled. Claims 1, 9 and 12 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 is directed to disembodied data structure claim which is per se not statutory. C.f. In re Wamerdam. The preamble of the independent claim 1 and all its recited limitations are directed to an ecommerce catalog and its contents which actually represent mere non-functional disembodied data structure which on its own cannot provide a tangible, concrete and useful result. The examiner suggests redrafting the claim to include a processor coupled to a memory storing the catalog data and a computer program/code to make the e-commerce catalog available to a user. **A claim to a computer readable medium encoded with functional descriptive material that can function with a computer/processor to effect a practical application resulting in a useful, concrete and tangible result (i.e. running an assembly line or executing a stock transaction) satisfies Section 101.** See U.S. Patent 5,710,578 to Beauregard

etc. i.e., **a set of instructions in combination with a computer system**. C.f. In re Wamerdam - data structure stored in a computer memory, and In re Lowery, 32 USPQ2d 1031 (Fed. Cir. 1994) - data structure in a computer readable medium.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 9, as best understood, it appears that the claimed method steps could simply be performed by mental process alone and are not statutory. The following passage comes from In re Comiskey, 499 F.3d 1365, 84 USPQ2d 1670 (Fed. Cir. Sep. 20, 2007):

It is thus clear that the present statute does not allow patents to be issued on particular business systems—such as a particular type of arbitration—that depend entirely on the use of mental processes. In other words, the patent statute does not allow patents on particular systems that depend for their operation on human intelligence alone, a field of endeavor that both the framers and Congress intended to be beyond the reach of patentable subject matter. Thus, it is established that the application of human intelligence to the solution of practical problems is not in and of itself patentable.

The independent claim 9 is directed towards steps of “providing different types products such as master targeted product, targeted product and a non targeted product for a catalog”, “making those products available to different group of customers” and “determining the master targeted product set and targeted product set in accordance with terms and conditions of an agreement” . Since the claims are directed to a process

(a) without transforming underlying subject matter to a different state or thing and
(2) without including another statutory class of invention (i.e. machine, manufacture, or composition of matter), these claims fall within the scope of human intelligence alone, and are non-statutory.

The examiner suggests, as an example only, to include a processor/computer/machine coupled to a memory and/or a computer network system to implement the recited functional steps.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 9 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Flaxer et al., hereinafter Flaxer.

Regarding claim 1, Flaxer discloses an e commerce catalog capable of offering a plurality of products for a vendor to prospective customers, comprising:

a master targeted product set of selected products that is not to be available to non targeted customers, a targeted product set for a targeted customer; and a non targeted product set available to targeted customers (see at least paragraphs 0008 and 0024-0027).

The subset catalog products and prices for group entitlement correspond to the

recited master targeted product set of selected products.

The subset catalog products of the customizable solution bundle supporting a unique range of functions including product customization based on programmed business rules correspond to the recited targeted product set for a targeted customer.

The subset catalog products of the customizable solution bundle spanning multiple groups being made available to any customer correspond to the recited a non targeted product set available to targeted customers.);

wherein said non targeted product set is available to public customers (see at least paragraphs 0008 and 0024-0027. The subset catalog products of the customizable solution bundle spanning multiple groups being made available to any customer and "any customer" includes public customers.);

wherein said catalog presents views of products from targeted product sets to respective targeted customers (see at least paragraphs 0008 and 0024-0027. The subset catalog products of the customizable solution bundle supporting a unique range of functions including product customization based on programmed business rules correspond to the recited targeted product set for a targeted customer and thus the customizable solution bundle presents the views of targeted product sets to targeted customers being supported by programmed business rules);

wherein said catalog presents a view of products from non targeted product sets to targeted customers and public customers (see at least paragraphs 0008 and 0024-0027. The subset catalog products of the customizable solution bundle spanning multiple groups being made available and presented to any customer and "any

customer" includes public customers as well as targeted customers);

wherein said master targeted product set is determined in accordance with terms and conditions of trading agreements between said vendor and said targeted customers (see at least paragraph 0024. The entire group support subset products are determined by a sanctioned business process and tools satisfying both front end and back end fulfillment systems); and

wherein each said targeted product set is determined in accordance with the terms and conditions of a trading agreement between said vendor and a respective targeted customer (see at least paragraph 0026. The subset catalog products of the customizable solution bundle supporting a unique range of functions including product customization *are based on programmed business rules*).

Regarding claims 9 and 12, their limitations are closely parallel to the limitations of claim 1 and are therefore analyzed and rejected on the basis of same rationale as set forth for claim 1 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex/Hoteling.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Yogesh C Garg
Primary Examiner
Art Unit 3625

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Primary Examiner, Art Unit 3625